

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Schwab et al

Serial No.: 09/900,827

Group No.: 2618

Filed: July 6, 2001

Examiner: E. Orgad

For: PORTABLE COMMUNICATIONS DEVICE

APPELLANTS' APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Barry H. Schwab and John G. Posa, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 7 claims. Claims 1-2 and 4 have been canceled. Claims 3 and 5-7 are pending, rejected and under appeal. Claim 3 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 3 is directed to a method of improving the hands-free operation of a communications device having a speed-dial function. The method includes the steps of storing a plurality of telephone numbers in the device in a list of numbers to be dialed; entering an abbreviated command to sequence through the list to dial each stored number; and automatically deleting a number from the list after a call to that number has been completed (Specification, page 3, lines 10-19).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 3 and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,804,338 to Chen in view of U.S. Publication No. 2002/0191776 to Khan.

VII. Argument

Claim 3 stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,804,338 to Chen in view of U.S. Publication No. 2002/0191776 to Khan.

Chen resides in an electronic telephone directory. Provisions are disclosed to automate the creation, update, and deletion of entries, depending on particular sets of circumstances. In general, the creation or retention of an entry is dependent on "importance" as measured by usage:

"A phone number related to certain operation is defined as an important/frequently used number under one or more of the following criteria:

- (1) a number from Caller ID memory has been called back for one or more than "n" times within a certain length of time;
- (2) a Caller ID number has been received repeatedly after and before a certain length of time (e.g. after 5 hrs and before 48 hrs.) for 2 or more than "n" times;
- (3) a number is repeatedly dialed out after and before a certain length of time (e.g. after 5 hrs and before 24 hrs.) for 2 or more than "n" times;
- (4) the last 7 digits of a manually dial out number is found to be matched with the last 7 digits of a number in Caller ID memory; and
- (5) For Caller ID on call waiting, that is, a Caller ID of a third party which is received while the user is already engaged in a telephone call, the user has at least 2 options to handle this new call. One option is to ignore this new call, and the other option is to accept the new call and switch to talk to the third party. If the present invention detects and records that a user has manually accepted such a call-waiting, the number found in the Caller ID on call waiting of this call is auto determined to be an important telephone number." (Chen, 1:61 - 2:18)

and:

"Another aspect of the invention is directed to automatic deletion of numbers. When the memory is full, those numbers which have not been dialed for 6 or "n" months or those with least dialing times are automatically deleted except those numbers which with VIP flag are kept for permanent storage." (2:19-24)

Thus, the entries in this list are not created to facilitate a particular sequence of calls, but rather simply are related to past calling patterns, with the intention of facilitating the recollection of these telephone numbers. Similarly, the deletion of an entry is not directly related to the success or failure of a particular call or series of calls, but instead is related to how often calls involving the number have been dialed or received, and whether the user has dialed a particular number more often than other numbers. Evidently, calls received from a particular number can be identified and factored into this decision only if those calls have Caller ID; thus, a caller who disables the Caller ID for his outgoing call will defeat the system, even as a user's receiving device must, of necessity, have provisions included to detect and decode Caller ID information of incoming calls in order to practice the teachings of Chen.

On page 2 of the Final Office Action, the Examiner states that Chen teaches "storing a plurality of telephone numbers in the device in a list of numbers to be dialed," citing Chen at 1:58-67. However, this is not what the Chen patent discloses. The cited passage reads as follows:

"The first aspect of the present invention is directed to a method and apparatus for automatic selection of those important/frequently used phone numbers and for automatic transfer of them to a permanent memory. A phone number related to certain operation is defined as an important/frequently used number under one or more of the following criteria: (1) a number from Caller ID memory has been called back for one or more than "n" times within a certain length of time;"

Thus, the memory elements cited by the Examiner are related to storing numbers in the permanent memory of the directory, and not in creating a call sequence list.

The Examiner further states that Chen teaches "entering an abbreviated command to sequence through the list to dial each stored number," citing Chen at 3:37-53. However, this section of Chen simply discusses the types of memories used in the base unit. One of these memories is "a Redial Numbers Memory 114 [which] stores a list of numbers that have been recently dialed by the unit." Apparently based upon this disclosure, the Examiner argues that since Chen teaches a redial function,

"this inherently ... speeds up dialing by utilizing abbreviated commands." But this teaching does not read on the corresponding element of Appellants' claim. Appellants are not claiming to have invented "speed dial." Rather, the subject element includes that limitation of "entering an abbreviated command *to sequence through the list to dial each stored number.*" Chen says nothing about sequencing through a list to dial each number stored in that list.

Furthermore, the Examiner has cited steps 210 and 211 in Fig. 2 of Chen as evidence that Chen teaches the automatic deletion of a number from the list. However, careful examination of Figure 2 reveals that the decision to delete an entry is solely related to receiving incoming calls having Caller ID information, and never related to any outgoing call activity.

The Examiner does concede that Chen "fails to specifically disclose automatically deleting a number from the list after a call to that number has been completed." To fill this void, the Examiner advances the combination of Chen and Khan "to eliminate unnecessary calls and therefore eliminate unnecessary communications costs." Apart from the fact that none of the references or Appellants' invention are concerned with "unnecessary communications costs," the Examiner's argument is without merit. Just because Appellants' system automatically deletes a number from a list after a call to that number has been completed does not guarantee that the number will not be called again. The step does necessarily "eliminate unnecessary calls," as numbers on the list may turn out to be "unnecessary." Nor does the element necessarily "eliminate unnecessary communications costs," or, at least, the Examiner has not provided any factual evidence in support of these conjectures.

On page 3 of the final Office Action, the Examiner states that "Khan teaches automatically deleting a number from the list after a call to that number has been completed (§0018 & 0019), a call list is processed until it is exhausted, meaning that until nothing is left – implying that records are removed from the list once they've been called)." [Emphasis added] But this is not the teaching of Khan. Rather, Khan resides in a system for managing entries in Call lists, as might be employed in a telemarketing environment. List entries are selected from a master list stored in a "host processor," and downloaded to a local call list:

"Outbound call campaigns, such as telemarketing campaigns, generally begin with a download by the call center of a call list, from which a call center will initiate a call campaign. The most effective call list is a list consisting of qualified leads, who are persons or organizations who are likely to purchase a particular product or service.

Qualified leads are generated using many techniques, which are well known in the telemarketing industry. Since a qualified lead is likely to purchase a product or service, a qualified lead is a preferred contact for a telemarketing campaign. However, a qualified lead may have already purchased the subject product or service of a telemarketing campaign before or shortly after the campaign is initiated but before the qualified lead is contacted during the campaign.” [0016]

and:

“A typical call list would be processed by an intelligent computer telephony system until it is exhausted, which could take many hours or days. Thus, as can be appreciated, during this time frame, there is a need to update the in-process call list on a routine basis in order to filter out contacts included in the list, which are no longer valid.” [0019]

However, this simply means that all of the entries on the list are processed by the call center employees — there is no suggestion that any entries on the list are modified or deleted on the basis of the results of the outbound calling activities. In contrast, this is the context of the list updating/modification process:

“The disclosed system performs the in-process call list update function on a routine basis, which is preferably performed daily during the nighttime hours, when the computer telephony system is not being used to initiate outbound calls. The call list update system initiates a scheduled communication with a host database and searches the host database to retrieve database updates made since the preceding call list update function. **The call list update system would then download, from the host database, those database elements for which updates have been entered.** The call list update system would then store the downloaded call list update file in a storage buffer in the computer telephony system. The system would then search the call list resident in the computer telephony system and identify those records for which updates have been downloaded.” [0020] [Emphasis added]

Thus, modifications to the call list are generated by data received from the host computer, and not as a result of any calls that may, or may not, have been placed by the call center personnel; this means they are not related to the outbound calling activities of the call center personnel.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is Appellants' position that the Examiner has not met the burden. Apart from speculation, the Examiner has pointed to no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. The expectation of success, if any, is dubious, and even if Chen and Khan were combined, the result would not teach or suggest all the claim limitations.

Claim 5:

With regard to claim 5, Examiner has stated "Chen teaches the step of leaving a number on the list for later recall if the call to that number could not be completed at the time it was dialed" (Chen teaches deleting a number after memory is full, col. 4 lines -6) [*sic*]. Appellants do not fully understand the purpose of this particular [incomplete] reference, but nevertheless argues that the motivation "to eliminate unnecessary calls and therefore eliminate unnecessary communications costs" makes no sense with respect to the additional step of "leaving a number on the list for later recall if the call to that number could not be completed at the time it was dialed."

Claim 6:

Claim 6 adds to method claim 3 that the abbreviated command is manually entered. Here the Examiner relies upon "official notice," arguing that it would be obvious "to provide the user with a wide variety of entry redial sequences." Again, however, rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements are not sufficient to establish a genuine issue of material fact." *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing *McElmurry v. Arkansas*

Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Claim 7:

Claim 7 adds to method claim 3 that the abbreviated command is spoken by a user. Here the Examiner relies upon "official notice," arguing that it would be obvious "to provide the user with a wide variety of entry redial sequences." Again, however, rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Conclusion

This application has been pending ALMOST SEVEN YEARS. For the arguments of record and the reasons set forth herein, Appellants believe that all pending claims are in condition for allowance, and Appellants seek the Board's concurrence at this time.

Respectfully submitted,

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Date: Feb. 20, 2007

APPENDIX A

CLAIMS ON APPEAL

3. In a communications device having a speed-dial function, a method of improving hands-free operation, including the steps of:
storing a plurality of telephone numbers in the device in a list of numbers to be dialed;
entering an abbreviated command to sequence through the list to dial each stored number; and
automatically deleting a number from the list after a call to that number has been completed.
5. The method of claim 3, including the step of leaving a number on the list for later recall if the call to that number could not be completed at the time it was dialed.
6. The method of claim 3, wherein the abbreviated command is manually entered.
7. The method of claim 3, wherein the abbreviated command is spoken by a user.

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APPENDIX B

EVIDENCE

None.

APPENDIX C
RELATED PROCEEDINGS

None.